

Appl. No. 10/707,658
Amdt. Dated: January 4, 2006
Response to Office Action Dated October 10, 2005

Remarks/Arguments:

This Amendment is intended to be a complete response to the Office Action dated October 5, 2005, and the case is now believed to be in condition for allowance. Accordingly, reconsideration is respectfully requested. Claims 1-6 are pending in the application, and stand rejected at present.

In response to the rejection to claim 3 under 35 U. S. C. 112, second paragraph, claim 3 has been amended herein to overcome the rejection.

Claims 1 – 6 were rejected under 35 U. S. C. 103(a) as being unpatentable over Parlar et al. (USP 6,631,764) in view of Fisher et al. (USP 3,753,903). The examiner suggests that the emulsion solution of Parlar et al. in view of Fischer et al. would inherently present a shoulder peak before the monomer peak when analyzed by gel permeation chromatography because the emulsions are substantially identical. Applicant respectfully points out that inherency of a claimed element of the invention is immaterial. That which is inherent in the prior art, if not known at the time of the invention, cannot form a proper basis for rejecting the claimed invention as obvious under 35 U. S. C. 103(a). See *In re Shetty*, 566 F.2d 81, 86, 195 U.S.P.Q. 753, 756-57 (C.C.P.A. 1977), See also *In re Naylor*, 369 F.2d 765, 768, 152 U.S.P.Q. 106, 108 (C.C.P.A. 1966) ("[Inherency] is quite immaterial if . . . one of ordinary skill in the art would not appreciate or recognize the inherent result"); *In re Rijckaert*, 9 F.3d 1531, 1533, 28 U.S.P.Q.2d 1955, 1957 (Fed. Cir. 1993). Quoting from *In re Spormann*, 363 F.2d 444, 448, 150 U.S.P.Q. 449, 452 (C.C.P.A. 1966), the court stated:

[T]he inherency of an advantage and its obviousness are entirely different questions. That which may be inherent is not necessarily known. Obviousness cannot be predicated on what is unknown.

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Combining the teachings of Parlar et al. with those of Fisher et al. would not result in the invention as claimed by applicants. Hence, Applicant submits that the rejection does not have proper basis and withdrawal thereof is in order.

Amendments to the independent claims have been made to place the application in condition for allowance. Amendments made to the independent claims are applicable to the claims dependent thereon. Applicants submit that this paper is fully responsive to the comments in the Office Action and respectfully solicit for this application to be granted in light of these amendments and remarks. If the Examiner believes that the prosecution of the application would be facilitated by a telephone interview, Applicants invite the Examiner to contact the undersigned at 281-285-8606. The Commissioner is hereby authorized to charge any fees that may be required, or credit any overpayment, to Deposit Account No. 04-1579 (56.0773).

Respectfully submitted,



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